

Remarks

In response to the withdrawal of allowable subject matter by the Office, Applicants have amended the claims to return the claims to include limitations as pending before the previous Final Office Action. Applicants had amended the claims in the previous response merely to further the prosecution of the present application and based upon the representations by the Office that the claims were allowable. For at least the reasons set forth herein, it is and has been Applicants' position that the claims pending before the previous Office Action are and were allowable over the prior art of record. Applicants respectfully request withdrawal of the rejections of the claims at least for the reasons presented herein.

Applicants hereby add new claims 27-34. Please note that new claims 27 and 29-34 generally correspond to previously pending claims 21, 24, 17-20, and 25, respectively, which were canceled in the previous response based upon the representation of allowable subject matter by the Office. Accordingly, claims 1-15, 22-23, and 26-34 are pending in the present application.

Claims 1-15, 22-23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0018124 A1 Mottur et al. in view of U.S. Patent No. 6,172,672 Ramasubramanian et al.

Applicants respectfully traverse the rejections and request allowance of all pending claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

Referring to claim 1, there is no motivation to combine the reference teachings in support of the rejection and the Office has failed to establish a *prima facie* 103 rejection for at least this reason.

Mottur is directed towards enabling a user to control a remotely located camera. The control enables the users to overcome problems in the art (see paragraph [0005] wherein a subject is out of the field of view of the camera or a

subject may move out of the field of view and the monitoring function of the camera is lost. Further, Mottur is directed towards overcoming problems in the art wherein control of camera motion is limited and reducing or minimizing delays in broadcasts of information. Id.

The Office states on page 3 of the Action that the combination is appropriate in order to capture a high-resolution still image from the low bandwidth streaming video, since it is preferable to include a snapshot function because often users like to have the ability to review a single frame of video. Applicants respectfully submit that the alleged motivational rationale presented by the Office fails to support a proper *prima facie* 103 rejection of the claims as set forth by applicable authority.

Relevant authority discussing proper motivation is clear that motivation must be based upon objective evidence of record or knowledge generally available. The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the present Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

For example, referring to page 5 of the Action in support of the combination of teachings of Ramasubramanian with teachings of Mottur, it is stated that it would have been obvious to combine the references since it is preferable to include a snapshot function. However, the preferred snapshot function referred to by the Office is *only "preferably" to the Ramasubramanian specification and not Mottur* and accordingly does not support any modification of Mottur.

Referring to the explicit teachings of Mottur, the Mottur disclosure is concerned with real time monitoring (see paragraph 0005). Mottur is concerned with overcoming problems in the art of allowing a user to control movements of a *video camera to provide real time monitoring of a subject* when the subject is out of view or moves out of view. Mottur is not concerned with providing a snapshot of the subject and such is irrelevant inasmuch as Mottur already provides a solution for permitting movement of the camera responsive to user control to provide the desired real time monitoring of Mottur. **There is absolutely no evidence that Mottur is concerned with still images.**

Apart from bald cursory statements only relevant to the teachings of Ramasubramanian and of no relevance or concern to the problems being overcome by Mottur, the Office has failed to recite any **evidence** of record to support the combination and accordingly the motivation is merely a subjective unsupported opinion of the Examiner.

To the contrary of a position to modify Mottur to provide still images, explicit teachings of Mottur make clear that Mottur is concerned with solving problems of reducing "choppy broadcasts" and making *video seamless* as opposed to providing still pictures as baldly alleged by the Office. Even if Mottur were modified as alleged by the Office, no solution to a problem of Mottur would be provided or facilitated by the modification since Ramasubramanian is concerned with problems of no relevance to the problems of Mottur. The bald allegation that it is preferable to provide a snapshot function is disputed by Applicants inasmuch as Mottur is not concerned with snapshots but with real time video monitoring of a subject.

In sum, there is absolutely **no evidence of record to support the subjective conclusory statement of the Examiner** in support of the combination of reference teachings. The only motivation presented in the Office Action is based upon **the Examiner's subjective belief or unknown authority which is insufficient as clearly**

held by the applicable authority. As set forth by the Federal Circuit, there is no motivation and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper. Further, Applicants have cited evidence including numerous teachings in the references themselves that one would not be motivated to combine the reference teachings.

Why would one look to modify Mottur with the teachings of Ramasubramanian when Mottur already provides a solution to the problems of concern to Mottur, the Office has identified no deficiency in the solution provided by Mottur, and Ramasubramanian is concerned with solving problems of no relevance to Mottur? The answer in view of the lack of any supporting objective evidence is the motivation can only result from improper reliance upon Applicants' disclosure. **However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination.** See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicants submit that the alleged motivation presented by the Examiner, if deemed sufficient, would open the door to numerous combinations of any art which would expand the capabilities of the reference being modified even though the expanded capabilities are not relevant to the problems or solutions of the reference being modified. Applicants submit that the mere combination of reference teachings to expand the capabilities of the disclosure being modified in a manner of no concern to the subject matter or problems of the disclosure being modified would effectively eliminate the requirement to provide proper motivational rationale to formulate a proper 103 rejection. The courts have not eroded or eliminated the requirement for proper motivation and have clearly stated that proper motivation must be supported by objective evidence of record. **The Federal Circuit has clearly stated that motivation may not be based upon the subjective belief of the Examiner or unknown authority.**

The Office has failed to establish proper motivation to combine the reference teachings. Accordingly, the Office has failed to establish a proper prima facie 103 rejection of claim 1 and the rejection is improper for at least this reason.

The claims which depend from claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 23, the Office alleges on page 8 that it is inherent that there are two different communication channels to allow the processes to take place simultaneously. Applicants assert that the reliance upon inherency is misplaced. In particular, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Multiplexing multiple input signals for communication upon a single channel are commonly implemented using time division or other multiplexing techniques. Accordingly, suitable alternatives exist apart from the plural channel limitations of claim 23. The existence of the alternatives is compelling evidence that the claimed limitations do not necessarily flow from the teachings of the prior art as required for proper reliance upon inherency. The reliance upon inherency is misplaced and the rejection of claim 23 is improper for at least this additional reason.

Referring to claim 11, it is stated on page 6 of the Office Action that Mottur fails to disclose or suggest *capture of a still frame*. The Office relies upon the teachings of Ramasubramanian to cure the deficiencies of Mottur. However, the Office has failed to provide proper motivation to support the combination of reference teachings and the 103 rejection of claim 11 is improper for at least this reason.

The claims which depend from claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 26, Mottur fails to disclose or suggest *acquiring a high resolution photograph using the video streamed from the one or more photo-video acquisition devices as a viewfinder*. Further, there is no motivation to modify the teachings of Mottur. Accordingly, claim 26 is allowable for at least this reason.

In addition, even if the teachings of Ramasubramanian are combined with the teachings of Mottur, the combination fails to disclose or suggest any *acquiring a photograph using video streamed from the acquisition device as a viewfinder*

inasmuch as Ramasubramanian is only directed towards *photographs of previously stored video files* which may not be fairly interpreted as disclosing a view finder. Claim 26 is allowable for at least the above-mentioned compelling reasons.

Referring to new claim 30, Mottur fails to disclose or suggest acquiring a high resolution *photograph* using the *video streamed from the one or more photo-video acquisition devices as a viewfinder*. Further, there is no motivation to modify the teachings of Mottur. Accordingly, claim 30 is allowable for at least this reason.

The claims which depend from claim 30 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 34, Mottur fails to disclose or suggest outputting a second command from the remote device and *providing still image data using the captured live video data responsive to the command*. Further, there is no motivation to modify the teachings of Mottur and claim 34 is allowable for at least this reason.

In addition, even if the teachings of Ramasubramanian are combined with the teachings of Mottur, the combination fails to disclose or suggest any *providing of still image data using captured live video data* inasmuch as Ramasubramanian is only directed towards *photographs of data of previously stored video files*. Claim 34 is allowable for at least the above-mentioned compelling reasons.

Support for the new claims is provided at least at Figs. 1-5 and the associated teachings of the originally filed specification.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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